

REMARKS

The final Official Action has been carefully studied. Upon entry of the amendments presented above, the claims in the application will be claims 26 and 28-32 only. Applicant submits that these claims define novel and unobvious subject matter under §§ 102 and 103 and should be allowed, and consequently Applicant respectfully requests favorable reconsideration, entry of the amendments presented above and allowance.

Acknowledgment by the PTO of the receipt of Applicants' papers filed under §119 is noted.

The method claims have been held by the PTO to be patentably distinct from the article claims as originally presented, and consequently claims 16-24 have been withdrawn from further consideration. Applicant accepts that the two inventions are patentably distinct from one another, i.e. each is patentable over the other as noted by the definition of "distinct" appearing at MPEP 802. This means that each is *prima facie* non-obvious from the other.

The non-elected claims 16-24 have now been deleted without prejudice to the present invention and also without prejudice to Applicant's rights to proceed with such claims and/or similar claims directed to the same invention in a divisional application, without any penalty whatsoever,

Applicant relying on the rights provided by law, including §§121, 120 and 119.

As regards the one word correction in the specification, the Examiner indicates that MPEP 1302.04 prevents the Examiner from making the correction. However, Applicant believes that MPEP 1302.04, part (J) permits the Examiner to do so as this is an obvious minor informality. Regardless, Applicant notes with appreciation that the Examiner has indicated that such a correction may be held in abeyance pending allowance.

Claims 25-28 and 30-32 have been rejected as obvious from Doerer in view of Barrable, both previously applied. Although Applicant appreciates the thoroughness and detail of the Office Action, Applicant nevertheless respectfully traverses this rejection.

Claim 25 is amended above to incorporate part of what was previously in the dependent portion of claim 26 and all of what was previously in the dependent portion of claim 27. Accordingly, the amendments presented above do not present any new issues.

In reply to the rejection, Applicant first respectfully repeats by reference the remarks of the preceding response, particularly commencing with the bottom paragraph on page 8 and proceeding through the top to the penultimate

paragraph on page 11<sup>1</sup>. Applicant will reply below to each of the points raised in the Final Action, but first wishes to add the following additional remarks.

Claim 25 calls for a building insulating material consisting essentially of (1) shredded fabric remnants, (2) flax fibers, and (3) fibrous polyester which acts as a bonding agent. (According to claim 29, the shredded fabric remnants part of the material may comprise up to 40% by weight of fibers obtained from shredded cardboard and/or waste paper.)

Doerer, the main reference relied upon, discloses a fibrous mat formed by what is said to be "a unique dry process", of a mixture of base fibers and carrier fibers (e.g. col. 1, lines 17-20). The base fibers are preferably cellulosic, and may come from reclaimable sources (e.g. col. 2, lines 10-14). As recognized in the rejection, and even though there is a relatively comprehensive basket or shotgun disclosure of base fibers (col. 2, lines 50-53; col. 3, lines 67 through col. 4, line 3), flax is not mentioned.

The carrier fibers, intended to soften during the process and thus provide a binding effect for the base fibers, may also be selected from a basket or shotgun disclosure of

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<sup>1</sup> Borger need not be again discussed, as it is not applied. On the other hand, Applicant respectfully reserves the right to rely on Borger if an appeal becomes necessary, as Borger teaches away from the present invention, pointing out the necessity of the use of a pure polyester fiber mixture.

possibilities, including a "material selected from the vinyl family, the polyester family, the polyolefin family, the polyamide family, and any physical or chemical combination of those families" (col. 4, lines 6-9). However, polyethylene and polypropylene are preferred. Polyesters are mentioned as a possible supplementary carrier fiber to provide hydrophobic properties, noting col. 6, lines 48 *et seq*, particularly line 62.

In one example, the mixture consists of 85% by weight wood fibers, 10% by weight polypropylene carrier fibers and 5% by weight of phenolic resin (col. 7, lines 5-8).

In another example, the mix consists of 85-87% wood fibers, 5% polyethylene resin, 5% phenolic resin, and 3-5% shoddy, the latter consisting of about 35% cotton and about 65% polyester (col. 7, lines 23-29).

The fibrous mat of Doerer is made by a dry process which is distinguished from a wet process. From column 2, commencing at line 43:

It is a primary object of this invention to provide a unique dry process of forming a flexible mat consisting essentially of base and carrier fibers, the base fiber being a natural or synthetic fiber, and the carrier fiber being a linking fiber adapted to intertwine or interlock with the base fibers.

Also see column 2, lines 3-5.

The importance of proceeding according to the dry process is emphasized at column 2, lines 32-38 as follows:

While satisfactory products can be made by the wet slurry process, it is a relatively expensive process not only in terms of the amount of energy required but also because of its long manufacturing cycle time and the cost of cleaning the effluent resulting from the process prior to dumping. This invention, however, relates to a dry process and product made therefrom.

Claim 25 also calls for the mixed fibers "to form an **aerated** homogeneous mass." Doerer is silent on this point. A rejection usually cannot be based upon silence in a reference.

Claim 25 calls for the polyester fiber to have a dtex value in the range of 2-10. Doerer is silent on this point.

The PTO recognizes at least some of the deficiencies of Doerer, and therefore relies on Barrable as a secondary reference to make up for some of these deficiencies. Applicant understands that Barrable is only relied upon as a secondary reference, primarily to allegedly show the equivalency between flax and other cellulosic fibers. Nevertheless, a full description is necessary to show not only its lack of relationship to the present invention, but also its lack of relationship to Doerer, and consequently that the person of ordinary skill in the art, wishing to modify any of the teachings of Doerer, would never be influenced by anything disclosed in Barrable.

Barrable discloses shaped articles, made by a wet method, which are "fire-resistant" and are composed primarily of inorganic materials, namely (a) a water-settable inorganic binder which is one or more of a calcium silicate binder, Portland cement, aluminous cement and blast furnace slag cement, (b) fibrous reinforcing material including organic fibers which do not melt below 140°C, and (c) mica and/or vermiculite, inorganic materials. How it can be validly said that a reading of Barrable would lead one toward the present invention is entirely unclear to Applicant.

The only similarity Applicant sees between the present invention and Barrable is that Barrable includes organic fibers which are "preferably cellulosic fibres" (column 2, lines 21 and 22), which can include waste wood pulps of all types, newsprint, as well as synthetic fibres (column 2, lines 27-31), including specifically "polyester fibres". Applicant sees no disclosure of presence of both polyester fibers **and** fibers obtained from fabric remnants and optionally recycled cardboard and/or wastepaper.

Applicant does not see that Barrable discloses the use of polyester fibers as a binding agent. Indeed, Barrable expressly teaches the use of an inorganic binder. To use

polyester fibers as a binder in Barrable would be to fly in the face of Barrable and destroy Barrable for its intended function<sup>2</sup>.

Claim 25 now further calls for the polyester to have a particular dtex value. Barrable, which does not show the use of any polyester in any example, and only mentions polyester as part of a large basket or shotgun disclosure, does not disclose or make obvious, like Doerer, the use of polyester having a dtex value of 2-10.

Claim 25 now also recites, by virtue of what was previously recited in the dependent portion of claim 27, that the polyester is present in the range of 5-50% by weight. Again, there is no disclosure, no teaching, no suggestion, not the remotest inference of the use of such a quantity of polyester in Barrable, particularly taking into account that if any polyester were to be present in any Barrable molded product, the polyester would not be present as a binder as it is in the building insulating material of claim 25.

Next, claim 25 requires that the mixture form an **aerated** homogenous mass. Applicant does not see formation of any aerated mass in Barrable. Indeed, the methods of making board as disclosed in Barrable will inevitably lead to dense board. No aeration is disclosed whatsoever.

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<sup>2</sup> It is also noted that polyester is only mentioned as part of a large basket or shotgun disclosure with no example being provided of the use of polyester for any purpose whatsoever.

As pointed out above, Doerer discloses a product which has been necessarily formed by a dry process, whereas Barrable discloses a product which has necessarily been formed by a wet process. This distinction alone would cause the person of ordinary skill in the art to not even consider Barrable in conjunction with Doerer. Such a person of ordinary skill in the art, if he were to look at these two patents together, would consider them utterly incompatible.

As regards the use of flax specifically, what possible reason could the person of ordinary skill in the art have for using flax in the Doerer product, even though it is mentioned as a possibility in Barrable? There is no reason or purpose which is disclosed in the prior art for such a use. Indeed, flax is a relatively expensive fiber, particularly compared to the inexpensive fibers preferred by Doerer. As there is no advantage disclosed in the prior art for the use of flax which is a more expensive fiber, no reason exists for its use and consequently there is no motive or incentive to substitute the more expensive fiber for the less expensive fiber.

Respectfully, the combination is only suggested in Applicant's own specification, and would not have been obvious to the person of ordinary skill in the art at the time the present invention was made.

Additionally, and even assuming *ad arguendo* that the combination were obvious, it still would not reach the present invention as called for in claim 25, because the resultant mixture of three different types of fibers would not "form an aerated homogenous mass" as claimed.<sup>3</sup>

Applicant now wishes to address various points raised in the final Office Action:

On page 4 of the Final Action, the PTO states as follows:

It would have been obvious to one having ordinary skill in the art to use flax fibers as the base fibers in Doerer et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use.

Applicant respectfully traverses and strenuously objects to such a conclusion. In this regard, Applicant respectfully relies on the recent case of *Ex parte Levengood*, 28 USPQ 2d 1300, 1301-1302 (BPAI 1993):

The examiner notes that each reference discloses a different aspect of the claimed process. The examiner also notes that all aspects were "well known in the art". The examiner then indicates that because the various aspects of the claimed process were individually known in the art, the modifications of the electrophoretic process of Levengood by exposing Levengood's plant materials to cell-associated materials in order to "graft" or otherwise incorporate the

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<sup>3</sup> Or include a polyester having a dtex value in the range of 2-10.

cell associated material into the plants was "**well within the ordinary skill of the art**" at the time the claimed invention was made.

We reverse the rejection because the examiner has used the wrong standard of obviousness.  
(Italics in original)

Similar to *Levengood*, the rejection in the present invention seems to be based in part on the assumption that it is proper to combine diverse elements from different references merely because it is possible to do so, but that is not the correct standard.

In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present **evidence** [footnote including cited cases, omitted], preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art **would have been led** to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. See, for example, *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). (Italics in original)

In the present case, as in *Levengood*, the prior art would not have led the person of ordinary skill in the art to Applicant's invention because only a disadvantage, greater cost, would result.

In this case, . . ., the only suggestion for the examiner's combination of the isolated teachings of the applied references improperly stems from appellant's disclosure and not from the applied prior art. *In re Ehrreich*, 590

F.2d 902, 200 USPQ 504 (CCPA 1979). At best the examiner's comments regarding obviousness amount to an assertion that one of the ordinary skill in the relevant art would have been able to arrive at appellant's invention because he had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness. See *Orthokinetics Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ 2d 1081 (Fed. Cir. 1986). That which is within the capabilities of one skilled in the art is not synonymous with obviousness. *Ex parte Gerlach*, 212 USPQ 471 (Bd. App. 1980). See also footnote 16 of *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 1092, 227 USPQ 337, 343 (Fed. Cir. 1985). (Emphasis added)

Simply because using flax is within the capability of "the general skill of a worker in the art" does not make it obvious to do so, particularly when there is no advantage to do so provided in the prior art.

Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of the ordinary skill in the art, that "would lead" that individual "to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988). *In re Newell*, 891 F.2d 899, 13 USPQ 2d 1248 (Fed. Cir. 1989). Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent application has done.

There is no motivating force in the prior art which would have impelled one skilled in the art to add more expensive flax

fibers to the Doerer mat when there is no apparent advantage to be gained by doing so.

The next statement appearing in the rejection at page 4 with which Applicant respectfully takes strong issue is the following:

...although Doerer et al. does not explicitly teach the limitations of melting point and size, it is reasonable to presume that said limitations are inherent to the invention.

It is not proper to presume inherency. In this regard attention is respectfully invited to *In re Brink*, 164 USPQ 247, 249, where the Court stated:

Absent a showing [by the PTO] of some reasonable certainty of inherency, the rejection ... must fail.

Also see *Ex parte Cyba*, 155 USPQ 756, 757 (1967) and *In re Oelrich*, 212 USPQ 323, 326 (CCPA 1981) where the Court said that the inherency of a feature must be "inevitable". It is neither inevitable nor reasonably certain that the polyester mentioned by Doerer as a possibility in a rather large basket disclosure, and not even the preferred material, has either the melting point or size recited in Applicant's claims.

As regards the alternate rational appearing towards the bottom of page 4 of the Final Action, Applicant respectfully reverts to *Ex parte Levingood*, *supra*. Merely because something is possible or within the ability of the person skilled in the

art, does not make it obvious. The burden is on the PTO to provide evidence to establish a *prima facie* case of obviousness.

As regards the commentary at the top of page 5 of the Final Action, again the PTO has provided no evidence.

With respect, the rejection is replete with commentary to the fact that this or that would have been obvious, but no evidence is presented as to such alleged obviousness. Moreover, in at least some cases where the rejection says this or that would have been obvious because of some advantage, the prior art does not teach such an advantage, i.e. it comes either from Applicant's specification (not available to the person of ordinary skill in the art at the time the present invention was made), or it comes from some unidentified source which the Applicant has a right to face and then rebut.

Lastly, Applicant must state that, as is clearly evident from a consideration of Doerer and Barrable, that these two citations are vastly different from one another, and this has been pointed out above. It is not proper to isolate one element from the teachings of a reference, in this case to isolate "flax" from Barrable, and then entirely ignore the remainder of the citation. Instead, the reference must be considered in its entirety, noting for example *In re Mercier*, 185 USPQ 774, 778 (CCPA 1975), where the Court stated:

Whether appellant's invention is obvious under 35 USC 103 depends at the outset upon the

propriety of the Board's simultaneous reliance on what Enk says is known in the art and disregard the rest of Enk's disclosures. We find several difficulties with this analysis.

.... These and other questions arise because the Board's approach fails to recognize that **all** of the relevant teachings of the cited references must be considered in determining what they fairly teach to one having ordinary skill in the art. [citations omitted; emphasis in the Court's decision]

The Court then continued further as follows:

The relevant portions of a reference include not only those teachings which would suggest particular aspects of an invention to one having ordinary skill in the art, but also those teachings which would lead such a person away from the claimed invention. [citation omitted]

Also see *In re Wesslau*, 147 USPQ 391, 393 (CCPA 1965), where the Court stated:

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such references fairly suggests to one of ordinary skill in the art.

Also see *In re Umbricht*, 160 USPQ 15, 19 (CCPA 1968) to the same effect.

Applicant's invention would not have been obvious from a consideration of Doerer in view of Barrable. Applicant respectfully requests withdrawal of the rejection.

As regards the rejection of claim 29, Vost has not been cited to make up for the deficiencies of Doerer in view of

Barable as pointed out above, and indeed does not do so.

Accordingly, claim 29 is patentable for the same reasons as pointed out above.

Applicant therefore respectfully requests withdrawal of this rejection as well.

Applicant believes that all points raised by the Examiner have been addressed. However, if Applicant has overlooked any point raised by the Examiner in the Final Action, Applicant's failure to address such point is not to be taken as acquiescence by Applicant of the stated position in the Final Rejection. Applicant decidedly disagrees with the various points raised in the Final Rejection.

Applicant respectfully requests favorable reconsideration and allowance.

Respectfully submitted,

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